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Richard M. Olsen

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JONES DAY

222 East 41st Street

New York, NY 10017-6702

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RICHARD M. OLSEN, DEVON S. BOWEN,  
CURTIS MEISSNER, and GILLES ZUMBACH

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Application 10/046,907  
Technology Center 2100

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Mailed: June 19, 2009

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*Before* HARRY HORTON, *Paralegal Specialist*.  
HORTON, *Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on April 23, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

The Appeal Brief dated March 5, 2007 does not contain a concise explanation of the subject matter defined in each of the independent claims

involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. § 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 C.F.R. § 41.37(c)(1)(v)) (2008).

Further review of the Appeal Brief dated March 5, 2007 reveals that the Appellants have entered evidence (*Foundations of Computer Science*, 12-16 (1992)). The Appellants did not state when this evidence was previously introduced into the record as required. The Appellants are hereby reminded that any reference to unentered evidence is not permitted. *See* 37 C.F.R. § 41.33. It is required that the Examiner acknowledge the evidence, clarifying for the record if it overcomes all rejections under appeal. The Appellants must set forth a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented.

When the Office holds the brief to be defective solely due to Appellant's failure to provide a Summary of the Claimed Subject Matter and corrected Evidence Appendix as required by 37 C.F.R. § 41.37(c)(1)(v) and (c)(1)(ix), an entire new brief need *not*, and should *not*, be filed. Rather, a *paper* providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v) and an amended Evidence Appendix as required by 37 C.F.R. § 41.37(c)(1)(ix) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. *See the Manual of Patenting Examining Procedures* (MPEP) § 1215.04 and § 711.02(b).

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- (1) to instruct Appellants to submit a corrected summary of claimed subject matter in accordance with the above instruction;
- (2) to properly respond to the new evidence (*Foundations of Computer Science*) submitted with the Appeal Brief filed March 5, 2007; and
- (3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

hh

JONES DAY  
222 East 41st Street  
New York, NY 10017-6702